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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,219	11/15/2005	Douglas McBain	OMNZ 2 00021	1372
7590	08/20/2008		EXAMINER	
Chief Intellectual Property Counsel Law Department Omnova Solutions Inc. 175 Ghent road Fairlawn, OH 44333-3300			LIU, XUE H	
		ART UNIT	PAPER NUMBER	
		4111		
			MAIL DATE	DELIVERY MODE
			08/20/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/534,219	MCBAIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	XUE LIU	4111	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11/15/2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3 is/are rejected.  
 7) Claim(s) 2-9 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 06 May 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 88 on page 7, line 25 in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because control apparatus 80, receiving cylinder 82, metering cylinder 84, transfer pump 86, electrical box 94, controls 96, and controller 98 are mislabeled in fig. 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be

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necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 22. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

4. The disclosure is objected to because of the following informalities: on page 14, line 4, "...need to be m" should read "...need to be run".

Appropriate correction is required.

***Claim Objections***

5. Claim 2 is objected to because of the following informalities: "one voids" should read "one of voids". Appropriate correction is required.
6. Claim 3 is objected to because of the following informalities: in "...one or more injection pressures for said coating compositions", "coating compositions" should read "coating composition". Appropriate correction is required.
7. Claims 4-9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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9. Claims 1-3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8-10 of copending Application No. 10/534264. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are obvious variants of the claims of Application No. 10/534264.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Application Claims	10/534264 Claims
1	<b>7 and 10</b>
2	<b>7-8 and 10</b>
3	<b>7 and 9-10</b>

In the preamble of claim 7 (claims 8-10 are dependent on claim 7) of Application No. 10/534264, a "method for ensuring the quality of in-mold coated thermoplastic parts" is narrower than a "method for assuring that coated molded articles meet predetermined quality standards, said articles being formed entirely in a mold" as cited in the preamble of applicant's claim 1 because the coated molded articles as reads on the coated thermoplastic part. In step a) of claim 7 "manufacturing an in-mold coated thermoplastic part by molding a thermoplastic using a first set of process conditions in a closed mold to form a substrate" is narrower than "said articles being formed entirely in a mold by a process that includes forming a substrate from a first composition using a first set of process conditions" as cited in the preamble of applicant's claim 1 because forming a substrate in a mold reads on forming a substrate in a closed mold. While the preamble

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of claim 7 does not positively recite the limitation "allowing said coating composition to cure on said substrate so as to provide a coated molded article" as required by applicant's claim 1, the coating composition has to be cured on the substrate in order to harden the coating thereby forming a coated thermoplastic part. While claim 7 does not positively recite the limitation that inspecting the coated thermoplastic part is performed "after said articles is removed form said mold" as cited in applicant's claim 1, it would have been obvious in the art to inspect the molded parts after removal from the mold since it would be more convenient to determine if the substrate exhibits voids after it is removed from the mold since the mold will not be obstructing the substrate. Claim 10 is taken to be identical to steps (i) through (iii) in claim 1 as the maintenance of a constant volume throughout the process is merely an optional limitation for claim 1.

In regards to claim 2, the claim is identical to claim 8 of Application No. 10/534264 except the limitation "first composition" as required by applicant's claim 2 reads on "thermoplastic" in claim 8 of Application No. 10/534264.

In regards to claim 3, the claims is identical to claim 9 of Application No. 10/534264 except the limitation "first composition" as required by applicant's claim 3 reads on "thermoplastic" in claim 8 of Application No. 10/534264 and the limitation "coating composition" as required by applicant's claim 3 reads on "thermoset" recited in claim 9 of Application No. 10/534264.

### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the “first set of process conditions” includes both process conditions for the first composition and the coating composition. However, in claim 1, the “first set of process conditions” applies to forming the first composition, while a second set of process conditions is used for forming the coating on the first composition. The different scopes of the “first set of process conditions” in claim 1 and claim 3 render the claim indefinite. For examining purposes, the claim is construed to have the first set of process conditions include process conditions for the first composition and the second set of process conditions include process conditions for the coating composition so that claim 3 is consistent with claim 1.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by McBain et al. (2002/0039656).

Regarding claim 1, McBain et al. teach a method for assuring that coated molded articles meet predetermined quality standards, said articles being formed entirely in a mold by a process that includes forming a substrate from a first composition using a first set of process conditions and

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subsequently, using a second set of process conditions, coating said substrate by injection a coating composition into said mold and allowing said coating to cure on said substrate so as to provide a coated molded article, said method comprising: Inspecting a first coated molded article manufactured by the process after said article is removed from said mold, determining whether said coated molded article meets quality standards for substrate formation and, if the article does not meet such standards, modifying the substrate formation step of the process by adjusting one of more of first composition injection volume (shot size), first composition injection temperature (temperature in the nozzle), and first composition injection pressure (injection high, injection pack, and injection hold), and determining whether said coated molded article meets quality standards for coating and, if the article does not meet such standards, modifying the coating step of the process by adjusting one or more of cure time and injection time (delays in seconds after mold is closed) at injection of said coating composition, and wherein the determination of whether said coated molded article meets quality standards for coating compares determining whether said coating is intermingled with said substrate, whether a surface appearance of said coating is acceptable, and whether said coating is sufficient adhered to said article (see abstract, paragraphs 2, 7, 13, 21, 53-55, 63-64, 66-71, 74-76, and tables II-III). While the claim recites that “said mold optionally having a constant volume maintained throughout the process”, however, McBain is not required to teach this limitation since this limitation is not positively required in the present claim.

Regarding claim 2, McBain et al. teach that the determination of whether said coated molded article meets quality standard for substrate formation comprises evaluating whether said article exhibits inadequate filling of said mold by said first composition (paragraph 64).

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Regarding claim 3, McBain et al. teach that the first set of process conditions includes one or more injection pressures for said first composition, one or more injection temperature for said first composition (temperature in the nozzle), one or more injection volumes for said first composition (shot size), and the second set of process conditions includes one or more injection times for said coating compositions (delay in seconds after mold is closed), and one or more cure times for said coating composition (see paragraphs 7, 66, 74, 76 and tables II & III). While McBain et al. do not positively teach that the second set of process conditions includes one or more injection pressures for said coating compositions and one or more injection volumes for said coating compositions, both injection pressures and injection volumes are inherent properties of any injection molding process.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to XUE LIU whose telephone number is (571)270-5522. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Yao can be reached on (571) 272-1224. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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